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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,173	12/31/2003	Edward B. Zalenski	3518.1020-000	5023
21005	7590	01/03/2006	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,173	ZALENSKI ET AL.	
Examiner	Art Unit		
Annette R. Reimers	3733		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

WHENEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 December 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 8-11, 14 and 16-30 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-7, 12, 13 and 15 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 30 August 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/30/04, 10/20/05, 10/26/05

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_ .

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election of Invention I, Claims 1-15, in the reply filed on December 12, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Examiner contacted Joseph Maraia, applicant's representative, on Monday, December 19, 2005, to determine which grabber, implant clip, and implant was being elected. Per the telephone conversation with Mr. Maraia, examiner further acknowledges applicant's election of Species (Grabber), Figure 2A, Subspecies (Implant Clip), Figure 3A, and Subspecies (Implant), Figure 4.

Examiner also acknowledges that applicant believes that claims 1-15 read on the elected Species/Subspecies of Figures 2A, 3A, and 4. Examiner agrees with applicant regarding all of the claims except claims 8-11 and 14, because the elected Grabber, i.e. Figure 2A, does not have dovetailed grabber tips, a second expansion/compression slot, or machined slots (see specification page 7, line 29, and page 8, lines 11-12 and 14-15). The dovetailed grabber tips, second expansion/compression slot, and machined slots are disclosed in Figure 2B, which was not elected by applicant. Thus, claims 8-11 and 14 have been withdrawn from further consideration on the merits.

Claims 8-11, 14 and 16-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 12, 2005.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Flivik et al. (US Patent Number 6,110179).

Flivik et al. disclose various embodiments of an implant implantation device comprising a frame having a trigger mechanism, 203, an outer sleeve, 201, mechanically coupled to the frame, an inner shaft, 204, having a grabber, 262, for mechanically engaging an implant, wherein the inner shaft is slidably disposed within the outer sleeve, and a retaining spring element, 205 for directing the grabber toward a closed position (see figures 16, 18, 19 and 23). The device further includes a drag adjustment screw, 215, rotatably coupled to the frame for providing tension between the trigger mechanism and the inner shaft, and a including a depth control member, 206,

slidably coupled to the outer sleeve, wherein the depth control member provides a predetermined insertion depth of the implant (see figures 16, 18, and 19). The device also includes a protrusion, 208, on the outer sleeve for slidably engaging a distraction instrument (see figure 18). Flivik et al. disclose a knob, 14, mechanically coupled to the outer sleeve in further embodiments, wherein the knob is capable of causing the outer sleeve and the inner shaft to be rotated about the frame (see figures 1 and 9).

The grabber includes grabber tips for mechanically engaging an implant (see figure 23). The grabber further includes markings, 265, to identify a position of an implant, and the grabber is capable of being removably coupled at 267 to the inner shaft (see figure 23).

Claims 1-7, 12-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Lim (US Patent Publication Number 2005/0055031).

Lim discloses an implant implantation device comprising a frame having a trigger mechanism, 60, an outer sleeve, 128 and 178, mechanically coupled to the frame, an inner shaft, 130 and 134, having a grabber, 122 and 124, for mechanically engaging an implant, wherein the inner shaft is slidably disposed within the outer sleeve, and a retaining spring element, 214 for directing the grabber toward a closed position (see figures 1, 2, and 11). The device further includes a drag adjustment screw, 63, rotatably coupled to the frame for providing tension between the trigger mechanism and the inner shaft, and a including a depth control member, 46, slidably coupled to the outer sleeve, wherein the depth control member is capable of providing a predetermined insertion depth of the implant (see figures 2 and 5). The device also includes protrusions 188,

190, 192 and 194, on the outer sleeve capable of slidably engaging a distraction instrument and a knob, 216, mechanically coupled to the outer sleeve (see figures 5 and 11).

The grabber includes grabber tips for mechanically engaging an implant (see figure 11). The grabber further includes a pin, 152, capable of identifying a position of an implant, and the grabber is capable of being removably coupled at 148 and 150 to the inner shaft (see figure 11).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Pedro Philogene*  
PEDRO PHILogene  
PRIMARY EXAMINER

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*AR*